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Goodhue, Coleman & Owens, P.C.
650 S. Prairie View Dr.
Suite 125, PMB #209
West Des Moines, IA 50266

EXAMINER

RAPILLO, KRISTINE K

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT H. LORSCH

Appeal 2017-000934
Application 13/736,340¹
Technology Center 3600

Before HUBERT C. LORIN, BRUCE T. WIEDER, and
ROBERT J. SILVERMAN, Administrative Patent Judges.

LORIN, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE

Robert H. Lorsch (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's Final rejection of claims 1, 6, 9–13, 16, 22, 27, 28, and 31. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We REVERSE.

¹ The Appellant identifies MyMedicalRecords, Inc., as the real party in interest. App. Br. 4.

CLAIMED INVENTION

Appellant's claimed invention "relates to the collection, storage, and/or management of online records" (Spec. ¶ 1).

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

Claim 1: A system comprising:

a card comprising (a) a first surface, (b) a second surface opposite the first surface, (c) a promotional code printed on the second surface, and (d) a scratch box on the second surface and overlaying the promotional code;

a web server configured to receive the promotional code on the card and activate a new, prepaid user account for collecting, storing, and managing personal health records in response to receiving the promotional code;

wherein the card further comprises an address associated with the web server printed on the card, a user identifier area on the first surface or the second surface of the card for completion by a registered cardholder to specify a user identifier, an emergency password area on the first surface or the second surface of the card for completion by the registered cardholder to specify an emergency password;

wherein the web server is configured to provide emergency personnel with access to a subset of the personal health records in the prepaid user account when the user identifier and the emergency password are used by the emergency personnel to log into the prepaid user account; and

product packaging for the card, the produce [sic] packaging including a back side and an opposite front side, the produce [sic] packaging including the address associated with the web server and instructions for using the card as an emergency access card to provide the emergency personnel with access to the subset of the personal health records in the prepaid user account when the user identifier and the emergency password are used by the emergency personnel to log into the prepaid user account;

wherein the product packaging includes a code for scanning at a point of sale.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Kwan	US 2003/0200179 A1	Oct. 23, 2003
Malone	US 6,640,974 B2	Nov. 4, 2003
Lorsch	US 2007/0233519 A1	Oct. 4, 2007
Mullen et al. ("Mullen")	US 2011/0276437 A1	Nov. 10, 2011

The following rejections are before us for review:

1. Claims 1, 6, 9–13 and 31 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Claims 1, 6, 11–13, 16, 22, 27 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mullen, Lorsch, and Malone.
3. Claims 9, 10, and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mullen, Lorsch, Malone, and Kwan.

ISSUES

Did the Examiner err in rejecting claims 1, 6, 9–13 and 31 under 35 U.S.C. § 101 as being directed to non-statutory subject matter?

Did the Examiner err in rejecting claims 1, 6, 11–13, 16, 22, 27 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Mullen, Lorsch, and Malone?

Did the Examiner err in rejecting claims 9, 10, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Mullen, Lorsch, Malone, and Kwan?

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer.
Additional findings of fact may appear in the Analysis below.

ANALYSIS

The rejection of claims 1, 6, 9–13 and 31 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

In challenging the rejection, the Appellant has explained that some of the very advantages derived from the claimed invention are due to the physical nature of the card and its packaging. [See]e.g. Specification, p. 8, lines 16–22; [“First, it may be used to provide a physical product which can be sold at retail locations such as retail stores, drug stores, supermarkets, hospitals, hospital gift shops, or other locations . . . the cardholder may carry the card in their wallet or on their person.”

App. Br. 12.

The Examiner responded by arguing that

The physical card is merely a physical document which is used to provide information to the web server; the claims are not an improvement to technology, but rather a computer function well-understood, routine, and conventional. The Appellant's originally filed [S]pecification discloses “[a] patient 102 or their proxy can communicate directly with the web server 108 through a computing device 109 (which may be, without limitation, a computer, tablet, smart phone, web-enabled device,) or the fax/voice server 106 using a phone 117” (page 11, lines 4–7) thus indicating a generic computer performing functions that are well understood, routine, and conventional activities previously known to the pertinent industry.

Ans. 2–3.

The Appellant countered:

This is not a fair characterization of the claims. Claim 1 includes specific language regarding the card such as “a first surface; a second surface opposite the first surface; a promotional code printed on the

second surface; a scratch box on the second surface and overlaying the promotional code.” The card as claimed is certainly more than merely a physical document and the purpose of the physical card is more than to provide information to the web server and thus is clearly more than merely a computer function. In particular, the card allows a for a physical product to be offered which is associated with services, the card conveys value associated with the services, but in a manner in which the promotional code is protected (with the scratch box) and the card may be used as a permanent emergency card for the recipient. Here the claims include specific limitations other than what is well-understood, routine, and conventional in the field.

Reply Br. 12–13.

In our view, the Appellant has the better argument. The question is a simple one: does the claimed subject matter entail an unconventional technological solution to a technological problem. *Cf. Amdocs (Israel) Limited v. Openet Telecom, Inc.*, No. 2015-1180, 2016 WL 6440387, *10 (Fed. Cir. Nov. 1, 2016):

[T]his claim entails an unconventional technological solution (enhancing data in a distributed fashion) to a technological problem (massive record flows which previously required massive databases). The solution requires arguably generic components, including network devices and “gatherers” which “gather” information. However, the claim’s enhancing limitation necessarily requires that these generic components operate in an unconventional manner to achieve an improvement in computer functionality. The enhancing limitation depends not only on the invention’s distributed architecture, but also depends upon the network devices and gatherers—even though these may be generic—working together in a distributed manner.

In that regard, the claimed combination of a card comprising a first surface and an opposite second surface with a scratch box, a web server and a product packaging for the card work together so as to satisfy a “need [for] a prepaid card for offering services related to personal health records.” Spec.

1:21–22. While the physical card is used to provide information to the web server, as the Examiner has argued, the claimed solution (to provide for a prepaid card for offering services related to personal health records) is necessarily rooted in the claimed system itself, most notably by providing

a card comprising (a) a first surface, (b) a second surface opposite the first surface, (c) a promotional code printed on the second surface, and (d) a scratch box on the second surface and overlaying the promotional code;[. . .] the card further compris[ing] an address associated with the web server printed on the card, a user identifier area on the first surface or the second surface of the card for completion by a registered cardholder to specify a user identifier, an emergency password area on the first surface or the second surface of the card for completion by the registered cardholder to specify an emergency password.

Claim 1. *Cf. DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) (“[T]he claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.”)

On balance, we find the record better supports the Appellant’s argument in that the claimed subject matter entails an unconventional technological solution to a technological problem. For that reason, the rejection is not sustained.

The rejection of claims 1, 6, 11–13, 16, 22, 27 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Mullen, Lorsch, and Malone.

Independent claim 1 calls for a card with a promotional code and “a web server configured to receive the promotional code on the card and activate a new, prepaid user account for collecting, storing, and managing personal health records in response to receiving the promotional code.” The other independent claim (claim 22) includes a similar limitation.

The Examiner takes the position that “Figure 9; paragraphs 15, 16, 79, and 99” of Mullen discloses this. Final Act. 4. The Appellants disagree. *See* App. Br. 14 (“Mullen never discloses activating a user account using a promotional code and does not teach “a web server configured to receive the promotional code on the card and activate a new, prepaid user account” as recited in claim 1.”) The Examiner counters by stating that “[t]he Examiner interprets the entering of the code online at a website to be a form of activation, as the entering of the code allows management of the user's payment information.” Ans. 3.

We find the Appellant has the better argument. We agree that “[t]here is no proper basis for the Examiner to make such an interpretation and the Examiner[] provides no reasoning in support of such an interpretation.” Reply Br. 15. The fact is that Mullen does not disclose “a web server configured to receive the promotional code on the card and activate a new, prepaid user account,” let alone to “activate a new, prepaid user account for collecting, storing, and managing personal health records in response to receiving the promotional code” as claimed. Entering a code online at a website does not necessarily involve activating a new, prepaid user account, let alone doing so for collecting, storing, and managing personal health records in response to receiving the promotional code. Mullen’s disclosure of entering a code online at a website is a broad disclosure that, without more, would not lead one of ordinary skill in the art to provide for a web server configured to perform the function as claimed.

For the foregoing reason, the rejection is not sustained.

The rejection of claims 9, 10, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Mullen, Lorsch, Malone, and Kwan.

This rejection of dependent claims 9, 10 and 28, is not sustained for the reasons discussed above in not sustaining the rejection of the independent claims.

CONCLUSIONS

The rejection of claims 1, 6, 9–13 and 31 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is reversed.

The rejection of claims 1, 6, 11–13, 16, 22, 27 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Mullen, Lorsch, and Malone is reversed.

The rejection of claims 9, 10, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Mullen, Lorsch, Malone, and Kwan is reversed.

DECISION

The decision of the Examiner to reject claims 1, 6, 9–13, 16, 22, 27, 28, and 31 is reversed.

REVERSED